IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
William Y. Conwell
Application No.: 09/670,113
Filed: September 26, 2000
For: METHOD OF PROCESSING TEXT FOUND IN IMAGES
Examiner: S. Patel
Date: December 3, 2007

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REPLY BRIEF

Sir:

This Reply Brief is responsive to the Examiner's Answer mailed October 17, 2007.

I. INCORPORTION BY REFERENCE

The *Examiner's Answer* makes a statement concerning Appellant's incorporation-by-reference of PN 6,614,9144 that, in one respect is confusing, and in another respect evidences a misunderstanding of the MPEP. The Examiner states (page 8):

> **(A). "Watermark" Limitation in Claims**
>
> Appellant argues that Federal Circuit of *In re Johnson* requires that the Examiner give claim terms the meanings imparted by applicant's specification, rather than other possible meanings. Error occurred in this case by the Examiner's construction of "watermark" to read on the bar code. The incorporated-by-reference document (USPN 6,614,914) makes clear that one of the attributes of a watermark is that it is essentially imperceptible.
>
> **Examiner's response:**
>
> Appellant states the portions from the incorporated-by-reference (USPN 6,614,914) in the Brief. However, this portion of the reference does not explicitly appear in the specification. As the examiner has stated that the clear explicit definition of "watermark" does not appear in the preferred embodiment (in present application). Therefore, the examiner is interpreting the "watermark" as broad as possible – as allowed by the MPEP 2111.

The first highlighted sentence appears to be an incomplete fragment.

The second highlighted sentence seems to suggest that incorporation-by-reference is not possible. But MPEP 2163.07(b) expressly permits incorporation-by-reference of the contents of published US patent documents, stating "*The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed.*"

Appellant properly incorporated-by-reference the '914 patent (then pending as application 09/503,881).[1] The Examiner's disregard of the '914 disclosure is error.

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[1] The paragraph bridging pages 1-2 of appellant's specification states (underling added):

> The database can be conventional, and is preferably accessible over the internet. A suitable

II. FEDERAL CIRCUIT'S RECENT DECISION IN *IN RE NUITJEN*

The Federal Circuit recently decided an appeal involving watermarking: *In re Nuitjen,* 2006-1371, September 20, 2007.

The issues in that case involved whether a watermarked signal constituted patentable subject matter. The Court's decision is naturally limited to its facts. However, the Federal Circuit's explanation of "watermarking" may be informative in assessing the meaning of this term to the artisan. The Court stated (highlighting added):

> **I. BACKGROUND**
>
> A. Nuijten's Invention and Patent Application
>
> Nuijten's patent application discloses a technique for reducing distortion induced by the introduction of "watermarks" into signals. In the context of signal processing, watermarking is a technique by which an original signal (such as a digital audio file) is manipulated so as to embed within it additional data. The additional data is preferably imperceptible to someone who views or listens to the signal—for instance, a listener who plays back a watermarked digital audio file would, if the watermark is sufficiently unobtrusive, not be able to distinguish between the watermarked and unwatermarked versions. However, an analysis of the file by software capable of detecting the watermark will reveal the mark's contents. This ability to encode additional data into a signal is useful to publishers of sound and video recordings, who can use watermarks to embed in the media they distribute information intended to protect that media against unauthorized copying. For these publishers and others, watermarking represents a trade-off: the desired additional data is encoded directly into the signal, but like any change to a signal, the watermark introduces some level of distortion. Thus, a key goal of watermarking techniques is to minimize the distortion so that the resulting diminution in signal quality is as minimal as possible.

Li's barcode is not a "watermark" within the meaning employed by *Nuitjen.*

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database system is disclosed in copending application 09/571,422, filed May 15, 2000. A variety of watermarking techniques are known. An illustrative set of techniques that can be employed in this application is disclosed in copending application 09/503,881, filed February 14, 2000. The disclosures of these applications are incorporated herein by reference.

III. SUFFICIENCY OF MOTIVATIONS TO COMBINE

The *Examiner's Answer* argues for affirmance of the § 103 rejections – primarily because the cited references teach that for which they are cited.

As noted in the original *Brief,* however, the rejections fail for want of a sufficient rationale explaining why an artisan would have sought to combine teachings from the references in the manner asserted. Lacking statements of sufficient rationales, the Office failed to meet its *prima facie* burdens.

For example, the stated rationale for claim 17 was:

> *The motivation for [combining the teaching of Venkatesan with Li] is to define a plurality of specific locations as suggested by Venkatasen at col. 13 lines 44-48.*

This is a statement of result, not motivation. It fails to explain 'why' an artisan would have been so-led.

The motivation offered for claim 8 is similarly flawed. The rationale offered in the Final Rejection was to "authenticate" a "document":

> *The motivation for doing so is to authenticate the document by encoding and digitally embedding element 45 into document 50 to as seen in Figure 3 and suggested throughout the invention of Li.*[2]

But neither reference speaks of authentication, and Alves does not concern a document. (The *Answer* now seeks to recast the motivation in terms of "verifying an image" (page 11), but the Final Rejection speaks for itself. Moreover, neither Li nor Alves mentions verification.) Again, the Office's *prima facie* burden has not been met.

Regarding claim 22, the *Answer* acknowledges that no motivation was offered; it seems to argue that claim 22 does not differ from claim 8. The claim language shows differently. Claim 22 newly introduces the requirement that the digital watermark "indicates the location of the stored text" in a data repository. Again, the Final Rejection failed to meet the Office's burden under § 103.

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[2] November 15, 2005, Final Rejection, page 4, 7th – 4th lines from bottom.

In remarks concerning claim 25, the *Answer* suggests that Conover's watermarking technique can be applied to Li's visible barcode, because the barcode is construed to be "compressed encoded data." But Conover does not teach how a barcode can be watermarked; Conover relates to altering compressed video data to watermark same.

Again, the issue is the motivation set forth in the Final Rejection. That motivation is confusingly unclear. That motivation is insufficient to lead an artisan towards the proposed modification and piecing-together of disparate elements from Li's FAX/barcode system, with Alves' parking garage toll system, with Conover's compressed-video marking system, in the manner proposed.

IV. CONCLUSION

Li does not anticipate, and none of the obviousness rejections meets the Office's burdens under § 103. Accordingly, the Board is requested to reverse the rejections and direct allowance of the claims.

Respectfully submitted,

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